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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,712	11/08/2005	Marc Eloit	270423US0XPCT	9314

22850 7590 06/11/2010  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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BURKHART, MICHAEL D

ART UNIT	PAPER NUMBER
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1633

NOTIFICATION DATE	DELIVERY MODE
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06/11/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/530,712	<b>Applicant(s)</b> ELOIT ET AL.	
	<b>Examiner</b> Michael Burkhart	<b>Art Unit</b> 1633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-28, 30, 31, 37-52 and 54-63 is/are pending in the application.
- 4a) Of the above claim(s) 25, 30, 37-51, 56-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 26-28, 31, 52, 54, 55, 61-63 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

Receipt and entry of the amendment dated 3/9/2010 is acknowledged. After entry of the amendment, claims 22-28, 30, 31, 37-52, 54-63 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 112***

Claims 52, 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, and for reasons set forth below.**

Claims 52 and 54 recite the limitation "the original replicating adenovirus" in line 6 of claim 52, and in lines 2-3 of claim 54. There is insufficient antecedent basis for this limitation in the claims. This rejection affects all dependent claims.

#### ***Response to Arguments***

Applicant's arguments filed 3/9/2010 have been fully considered but they are not persuasive. Applicants essentially assert that the claims have been amended such that the rejection is moot. As set forth above, this is not the case.

***Claim Rejections - 35 USC § 102***

Claims 22, 26-28, 31, 52, 54 and 55 are rejected under 35 U.S.C. 102(b) as being taught by Soudais et al (2001, of record). **This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, and for reasons set forth below.**

***Response to Arguments***

Applicant's arguments filed 3/9/2010 have been fully considered but they are not persuasive. Applicants essentially assert that: 1) Soudais et al do not teach the claimed virus which must replicate and produce infectious particles, primarily because the viruses of Soudais et al do not comprise the E1 region; 2) the vectors of the instant claims have a deletion which ends before the beginning of the E1A coding region, and are thus distinguished from those taught by Soudais et al.

Regarding 1), such is not convincing for reasons of record. The viruses of Soudais et al replicated and produced infectious particles in DKCre or DK neo cells (Materials and Methods, page 632, first column) that provide the E1 protein for reasons of record. Applicants do not explain why this does not anticipate the instant claims, which are not limited to the type of cell the claimed viruses must replicate in. The viruses of Soudais et al are indeed "replication-defective" in any cell type that does not complement the E1 deletion found in these viruses, but, as Soudais et al demonstrate, E1-expressing cells do produce infectious viral particles and allow viral replication. Again, see the Soudais et al page 636, second column to page 638: and entire section is entitled "Replication of the Test Vectors."

Regarding 2), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a

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deletion which ends before the beginning of the E1A coding region") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 103***

Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soudais et al (2001, of record) in view of Haddada et al (U.S. patent 6,294,377, 2001). **This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, and for reasons set forth below.**

### ***Response to Arguments***

Applicant's arguments filed 3/9/2010 have been fully considered but they are not persuasive. Applicants essentially assert that: 1) Haddada et al does not make up for the deficiencies of Soudais et al as set forth above; 2) the vectors of both Soudais and Haddada et al are not taught to be replicative.

Regarding both 1) and 2), Soudais et al is not considered to have any deficiencies regarding claim 22 for the reasons set forth above. Again, the vectors of both Soudais and Haddada et al are replicative in complementing, E1-expressing cell lines.

***Allowable Subject Matter***

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Burkhardt whose telephone number is (571)272-2915. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Burkhardt/  
Primary Examiner, Art Unit 1633